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10/576,087	04/14/2006	Masaki Ishibashi	1163-0557PUS1	6716

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EXAMINER

KHATIB, RAMI

ART UNIT	PAPER NUMBER
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3663

NOTIFICATION DATE	DELIVERY MODE
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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/576,087	Applicant(s) ISHIBASHI ET AL.	
	Examiner RAMI KHATIB	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 5,6 and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species A1 in the reply filed on 04/15/2009 is acknowledged.
2. Claims 4-5 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 04/15/2009.
3. Newly submitted claims 10-13 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 10-13 are directed to a car navigation method and the method as claimed can be practiced by hand such as the driver can determine an intended route and his location with respect to that intended route using a paper map, and he can also use a detailed paper map to locate the nearest intersection close to his position and the surrounding facilities with respect to his location or the desired intersection selected from that paper map.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 10-13 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 09/13/2004. It is noted, however, that applicant has not filed a certified copy of the JP 2004-265352 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

Art Unit: 3663

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 1-3, 6-7, and 9 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Daizen (JP 2003172624 which translation was done by the Examiner).

Regarding claim 1, Daizen discloses in Fig 1-2 a car navigation apparatus for searching facilities in a vicinity of an intersection which exists on a route comprising: a map data acquiring unit (i.e. map information retrieve unit 12 associating with drive device) for acquiring map data including road data, intersection information, and facility information ([0016]-[0017]); a route searching unit (i.e. control device 1) for searching for a route to a destination based on the map data acquired by the map data acquiring unit (Fig 3; [0018]+); an intersection searching unit (i.e. intersection search unit 11 of control device 1) for searching intersections in a vicinity of the current position from among intersections which exist on the route between the current position and the destination (Fig 3-10; [0016]-[0026]); an intersection name outputting unit (i.e. output unit 14 of control device 1 in conjunction with display device 6) for outputting intersection names which identify the intersections searched by the intersection searching unit, in order to allow a user to designate at least one of the intersection names (Fig 3, 9-10; [0016]-[0026]); an intersection selecting unit (i.e. control device 1 in conjunction with display device 6 and touch panel device 7) for selecting an intersection by specifying an intersection name designated by the user (Fig 3, 9-10; [0017]+; [0021]+); a facility searching unit (i.e. control device 1 in conjunction with display device

Art Unit: 3663

6 and touch panel device 7) for searching for facilities which exist in a vicinity of the intersection selected by the intersection selecting unit through the map data acquired by the map data acquiring unit (Fig 3-10; [0016]-[0026]); and a facility name outputting unit (i.e. output unit 14 of control device 1 in conjunction with display device 6) for outputting facility names which identify the facilities searched by the facility searching unit (Fig 3, 9-10; [0016]-[0026]). Also, Daizen inherently discloses a current position detecting unit for detecting a current position of a car (Fig 10; [0017]+; [0022]+).

In the event that Daizen does not disclose the inherency, it is well known in the art of car navigation system to include a GPS receiver or a self-contained navigation sensor as a current position detecting unit for detecting a current position of a car (i.e. support for the well known can be found in the IDS reference - US 6,859,724). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such GPS receiver or a self-contained navigation sensor in the navigation system of Daizen for detecting a current position of a car since it is well known in the art of navigation system.

Note: The statements of intended use or field of use, “for acquiring”, “for detecting”, “for searching”, “for outputting”, “for selecting”, are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See In re Pearson, 181 USPQ 641; In re Yanush,

Art Unit: 3663

177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2d 1647.

See MPEP § 2114 which states:

A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2d 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Regarding claim 2, Daizen discloses in Fig 1-2 a facility searching condition setting unit (i.e. control device 1 in conjunction with display device 6 and touch panel device 7) for setting facility searching conditions for specifying facilities which are a target to be searched, and the facility searching unit searches for facilities which exist in a vicinity of the intersection selected by the intersection selecting unit from the map data acquired by the map data acquiring unit according to the facility searching conditions set by the facility searching condition setting unit (Fig 3-10; [0016]-[0026]).

Regarding claim 3, Daizen discloses in Fig 3, 9-10 the facility searching conditions set by the searching condition setting unit include a distance from the intersection selected by the intersection selecting unit ([0022] +).

Art Unit: 3663

Regarding claim 6, Daizen discloses in Fig 1-2 the intersection selecting unit and the facility selecting unit are provided with a key, a remote controller, a touch panel, or a voice recognition device for specifying an intersection name outputted by the facility name outputting unit and a facility name outputted by the facility name outputting unit ([0016]-[0017]).

Regarding claim 7, Daizen discloses in Fig 1-2 an intersection searching condition setting unit (i.e. control device 1 in conjunction with display device 6 and touch panel device 7) for setting intersection search conditions for specifying intersections which are a target to be searched, and the intersection searching unit searches for intersections in a vicinity of the current position from among intersections which exists on the route between the current position and destination according to the intersection searching conditions set by the intersection searching condition setting unit (Fig 3, 6-8; [0017]; [0019]-[0026]).

Regarding claim 9, Daizen discloses a facility selecting unit (i.e. control device 1 in conjunction with display device 6 and touch panel device 7) for selecting a facility by specifying a facility name outputted by the facility name outputting unit (Fig 3-5; [0016]-[0026]); and a facility information outputting unit (i.e. control device 1 in conjunction with display device 6) for extracting facility information about the facility selected by the facility selecting unit from the map data acquired by the map data acquiring unit, and for outputting the facility information (Fig 3-10; [0017]-[0026]).

Art Unit: 3663

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Daizen as applied to claim 1 above, and further in view of Komatsu (IDS reference – US 6,859,724).

Regarding claim 8, Daizen does not explicitly disclose the apparatus includes an angle sensor for detecting a traveling direction of the car, and an expected-route-to-be-followed determining unit for determining an expected route to be followed by the car in case that the destination is not designated, based on the traveling direction detected by the angle sensor and the map data acquired by the map data acquiring unit, and the intersection searching unit searches for intersections in a vicinity of the current position through intersections which exist on the expected route to be followed determined by the expected-route-to-be-followed determining unit when no route is searched for by the route searching unit. Komatsu teaches in the same field of endeavor in Fig 1, 3-6 an angle sensor (angle sensor 6a) for detecting a traveling direction of the car, and an expected-route-to-be-followed determining unit (i.e. controller 17) for determining an expected route to be followed by the car in case that the destination is not designated, based on the traveling direction detected by the angle sensor and the map data acquired by the map data acquiring unit (i.e. DVD-ROM 1 in conjunction with navigation device 10), and the intersection searching unit (i.e. controller 17) searches for intersections in a vicinity of the current position through intersections which exist on the expected route to be followed determined by the expected-route-to-be-followed determining unit when no route is searched for by the route searching unit (col 3, lines 53-67; col 4, lines 20-25; col 4, line 44 - col 5, line 30; col 5, line 34 - col 7, line 25). It

Art Unit: 3663

would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate such angle sensor, expected-route-to-be-followed determining unit, and intersection searching unit as taught by Komatsu in the system of Daizen because it does no more than yield predictable results of determining the direction and intersection while traveling since it has been held that the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results (MPEP 2143).

10. As to limitations which are considered to be inherent in a reference, note the case law of In re Ludtke, 169 U.S.P.Q. 563; In re Swinehart, 169 U.S.P.Q. 226; In re Fitzgerald, 205 U.S.P.Q. 594; In re Best et al, 195 U.S.P.Q. 430; and In re Brown, 173 U.S.P.Q. 685, 688.

11. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of claims. See In re Mraz, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972).

Response to Arguments

12. Applicant's arguments filed 10/08/2009 have been fully considered but they are not persuasive.

13. With respect to applicant argument on page 7 of the applicant arguments/remarks that nowhere in Daizen does it teach or suggest searching for facilities in the vicinity of the intersection designated by the user, the examiner respectfully disagree with that statement. Daizen teaches a facility searching unit (i.e.

Art Unit: 3663

control device 1 in conjunction with display device 6 and touch panel device 7) and the claim language “for searching for facilities which exist in a vicinity of the intersection designated by the user” is essentially method limitations or statements of intended or desired use. Daizen teaches a facility searching unit (i.e. control device 1 in conjunction with display device 6 and touch panel device 7) and if programmed, the control device 1 in conjunction with display device 6 and touch panel device 7 is capable of searching for facilities which exist in a vicinity of the intersection designated by the user. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference.

Conclusion

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3663

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RAMI KHATIB whose telephone number is (571)270-1165. The examiner can normally be reached on Monday-Friday/8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. K./
Examiner, Art Unit 3663

/Jack W. Keith/
Supervisory Patent Examiner, Art Unit 3663